

REMARKS/ARGUMENTS

Favorable reconsideration of this Application, in light of the following discussion, is respectfully requested.

This Request for Reconsideration is in response to the Office Action mailed on August 19, 2005. Claims 1-19 are pending in the application stand rejected.

In the outstanding Office Action, Claims 1-19 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-9 of *Sunago et al.* (U.S. Patent No. 6,019,752, hereinafter “Sunago”); Claims 1-3 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Haber et al.* (U.S. Patent No. 5,352,196, hereinafter “Haber”); and Claims 4-6 and 8-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Haber in view of Sunago.

In response to the double patenting rejection, Applicants respectfully submit that (1) the outstanding Office Action failed to follow the proper procedure for such a rejection; and (2) Claims 1-9 of Sunago do not render obvious the inventions recited in Claims 1-19.

“A double patenting rejection of the obviousness-type is “analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103” except that the patent principally underlying the double patenting rejection is not considered prior art.¹ “Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination.² As such, “any obviousness-type double patenting rejection should make clear: (A) the differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and (B) the reasons why a person of ordinary skill in the art would conclude that

¹ MPEP § 804(II)(B)(1), citing *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967).

² MPEP § 804(II)(B)(1), citing *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.”³

First, Applicants submit that the outstanding Office Action has failed to point out the differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and to provide the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent. As such, the Office has not complied with the burden placed thereon by the current patent examining procedures for a double patenting rejection.

In addition, Applicants respectfully submit that Claims 1-9 of Sunago do not render obvious the inventions recited in Claims 1-19 of this application. Considering, for example, and not a limitation, Claim 1 of this application, in which a infusion container is recited, comprising, among other features, a dissolving liquid storing chamber and a medicine storing chamber which holds a small container having an open mouth and storing a freeze-dried medicine.

Sunago discloses a fluid vessel with a solvent chamber 2 and a drug storing chamber 1. The drug storing chamber, however, stores the drug in itself (see, for example, Sunago, col. 3, first paragraph) and no small container is disclosed. Thus, Sunago cannot support a prima facie of obviousness. This is so because Claims 1-9 of Sunago do not teach or suggest all the features recited in Claim 1. Similar arguments can be made for the other independent claims of this application. For the foregoing remarks, Applicants respectfully request withdrawal of double patenting rejection of Claims 1-19.

³ MPEP § 804(II)(B)(1).

Turning to the obviousness rejections, Applicants respectfully submit that Haber does not support a *prima facie* case of obviousness of the invention recited in Claim 1. This is so because this reference does not teach or suggest all the claimed features.

As already explained, Claim 1 recites a infusion container, comprising, among other features, a dissolving liquid storing chamber and a medicine storing chamber which holds a small container having an open mouth and storing a freeze-dried medicine.

The Office asserts that the cylinder 208 of Haber is a small container having an open mouth in the absence of the piston 228. In addition, the Office asserts that Applicants' invention comprises an open-mouth assembly that contains a piston 20. Applicants respectfully disagree with the mischaracterization of both Haber and Applicants' invention.

In Haber, the piston 228 is never removed (see the illustration of the Haber's apparatus in the inactivated, telescopically extended condition in FIG. 11A and of the fully activated, telescopically collapsed condition in FIG. 11B). Thus, a suggestion to the contrary would be a suggestion that would make the device of Haber unsatisfactory for its intended use.

In Applicants' invention, element 20 is not a piston, but a rubber plug. In addition, as clearly illustrated as an example and not a limitation in FIG. 1 of Applicants' disclosure, the rubber plug 20 is not placed over the small container 15.

Accordingly, Haber does not render obvious the invention recited in Claim 1. Claims 2, 3, and 7 should be allowed, among other reasons, as depending either directly or indirectly from Claim 1, which should be allowed as just explained.

In addition, Claims 2, 3, and 7 are further considered allowable as they recite other features of the invention that are not disclosed, taught, or suggested by the applied references when those features are considered within the context of the subject matter recited in

independent Claim 1. For the foregoing remarks, Applicants respectfully request withdrawal of the rejection of Claims 1-3 and 7 under 35 U.S.C. § 103(a).

As to the rejection of Claims 4-6 and 8-19, Applicants respectfully submit that Haber and Sunago, neither individually nor in any combination, support a *prima facie* case of obviousness of the invention recited in the rejected claims. This is so because, even when combined, these references do not teach or suggest all the claimed features.

The deficiencies of Haber have already been discussed hereinabove. It is unclear from the outstanding Office Action why Sunago is being cited. It seems to Applicants that Haber is the primary reference being modified by the teachings of Sunago. However, in the explanation of that rejection, it appears that it is Sunago that is being modified by the teachings of Haber. Nevertheless, as already discussed in the double patenting rejection, Sunago does not remedy the deficiencies of Haber. In addition, placement of longitudinal grooves in the device of Haber would certainly cause it to malfunction because of the leaks that would be created by such grooves. In addition, the rotation in Haber is of the protective housing 227 and not of any capping member as recited in Applicants' claims.

Accordingly, Haber and Sunago, neither individually nor in any combination, render obvious the invention recited in Claims 1, 10, and 12. Claims 4-6, 8, 9, 11, and 13-19 should be allowed, among other reasons, as depending either directly or indirectly from Claims 1, 10, and 12, which should be allowed as just explained.

In addition, Claims 4-6, 8, 9, 11, and 13-19 are further considered allowable as they recite other features of the invention that are not disclosed, taught, or suggested by the applied references when those features are considered within the context of the subject matter recited in independent Claims 1, 10, and 12. For the foregoing remarks, Applicants

respectfully request withdrawal of the rejection of Claims 4-6 and 8-19 under 35 U.S.C.

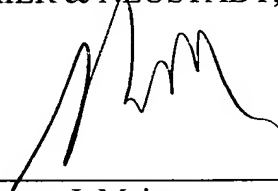
§ 103(a).

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-19 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representatives at the below listed telephone number.

Respectfully submitted,

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